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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/222,460	12/29/98	HAMMERMAN	M A-64236-3-RF
FLEHR HOHBACH TEST ALBRITTON & HERBERT SUITE 3400 FOUR EMBARCADERO CENTER SAN FRANCISCO CA 94111-4187		HM12/0405	EXAMINER
		MOE7TF.E	ART UNIT
			PAPER NUMBER
		1653	16
		DATE MAILED:	04/05/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

**Office Action Summary**

Application No. 09/222,460	Applicant(s) Hammerman, Et al
Examiner F. T. Moezie	Group Art Unit 1653

Responsive to communication(s) filed on 11/21/00 and 6/30/01

This action is FINAL.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

**Disposition of Claims**

Claim(s) 1-21 is/are pending in the application.

Of the above, claim(s) 2, 10-16, 18, and 19 is/are withdrawn from consideration.

Claim(s) \_\_\_\_\_ is/are allowed.

Claim(s) 1, 3-9, 17, and 20 is/are rejected.

Claim(s) 1, 3-9, 17, and 20 is/are objected to.

Claims 1-21 are subject to restriction or election requirement.

**Application Papers**

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119**

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

**Attachment(s)**

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). 14

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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### DETAILED ACTION

#### STATUS OF CLAIMS

Claims 1, 3-9, 17 and 20 are pending prosecution in this Office action.

Claims 1-11 were originally filed. The claims were subjected to a Restriction Requirement and Election of Species on 9/16/99. Applicant elected IGF-I as the growth factor. New claims 12-21 (not designated new) were added on 3/27/00. Claims 1-21 were Restricted again on 6/01/00. Applicant this time elected VEGF, and indicated claims reading thereon as being claims 1,3-9, 17 and 20, without traverse.

Claims 2, 10-16, 18, 19 and 21 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 12, received Aug. 21, 2000.

The restriction requirement is made FINAL. Cancellation of non-elected claims is advised.

Claim 6 is rejected under 35 USC 112, second paragraph, as being substantially identical with claim 1. Claim 1 is drawn to treating a tissue that is "transplanted", hence in-vivo and already transplanted. Claim 6 is excessive.

Claim 9 remains rejected under 35 USC 112, second paragraph, as being indefinite regarding the use of "such that". Cancellation of the term is suggested as it is excessive.

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**CLAIMS I, 3-9, 17 AND 20 ARE OBJECTED TO AS THEY ENCOMPASS NON-ELECTED SUBJECT MATTER.** Cancellation of the non-elected subject matter will overcome this ground of objection.

**REJECTION - 35 USC 102 (a) and 35 USC 103 (a)**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

Claims 1, 6, 8, 9, and 17 are rejected under 35 U.S.C. 102(a) as being anticipated by EP 0 853 842, published 7/22/98.

The reference discloses: "The growth factors are preferably administered to the host continuously, for example, by subcutaneous osmotic pumps, until the metanephric tissue has sufficiently developed. Alternatively, growth factors that promote angiogenesis such as vascular endothelial growth factor (VEGF), could be administered to the site of the implant at the time of implantation", page 5 lines 12-15. See the entire document, especially pages 1-5 and claim 27. The claims being drawn to a subject matter taught by the art, are anticipated by the art.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 1, 3-9, 17 and 20 are rejected under 35 USC 103 (a) as being obvious over EP 0 853 842.

The reference teaches that the subject matter being claimed has been disclosed by another prior to the applicant's invention, as cited above. The variations claimed are, such as contacting the tissue prior to transplantation for certain periods of time is considered routine and well within the skill of an ordinary art skilled.

#### **RESPONSE TO REMARKS**

Applicant's arguments filed Jan. 30, 2001, paper no. 15, have been considered and found persuasive in-part.

The Obviousness Double Patenting rejection of the claims over US Patent No. 5,976,524 in view of Robert et al is withdrawn.

The rejection of claim 9 under 35 USC 112, second paragraph, is maintained for the reasons cited earlier and above.

A new Declaration has not been received. See page 2 of remarks.

#### **CONCLUSION**

No claim is allowed.

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Any inquiry concerning this communication should be directed to F.T. Moezie at  
telephone number (703) 305-4508 fax (703) 305-7401.

*F.T. Moezie*  
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PRIMARY EXAMINER  
ART UNIT 1653